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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jon A. Brewster et al

Confirmation No.: 2318

Application No.: 09/325040

Examiner: J. Myhre

Filing Date: Jun 07, 1999

Group Art Unit: 3622

Title: Document Delivery System For Automatically Printing A Document On A Printing Device

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on Aug 08, 2004. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

No fee is required for filing of this Reply Brief.

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10991693-1

REPLY BRIEF

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re application of: Jon A. Brewster et al Art Unit: 3622
Examiner: J. Myhre

Serial Number: 09/325,040

Filed: June 7, 1999

10 Title: Document Delivery System for Automatically Printing a
Document on a Printing Device
Date: September 30, 2004

REPLY BRIEF UNDER 37 CFR §1.193

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TO THE ASSISTANT COMMISSIONER FOR PATENTS

Siri

20 This Reply Brief is submitted in response to the Examiner's Answer of
August 8, 2004. A Request for Oral Hearing accompanies this Reply Brief.

It seems quite apparent to the Appellants, and presumably to the Board as well, that the only cited prior art relevant to this case – the Griebenow, Austin, and Logan references, do not disclose, teach, or suggest Appellants' invention as claimed. The Examiner admits as much in his Examiner's Answer by deviating from these references and basing large portions of his arguments on anecdotal interpretations of allegedly prior art that is not of record in this case. Specific examples of this are shown below:

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1) The feature of letting users designate a time or frequency for delivery of a newspaper, a publication, a report, a financial statement, etc, has been well known in society for decades, if not centuries. [Examiner's Answer, Page 10]

5 2) One having ordinary skill in the art at the time the invention was made would not only have known of many other systems which incorporate this feature, but would also have known the advantages to the user in being able to select the desired frequency. [Examiner's Answer, Page 10]

10 3) When setting up an investment portfolio, it is common for the user (investor) to indicate his preference for receiving the investment report (e.g., weekly, monthly, quarterly, annually, etc). Different investors would have different desires on the frequency. A casual investor which invests a lump sum once a month (such as in an employee savings plan) would be happy receiving the report monthly or even quarterly. However, an active investor who makes investments and withdrawals daily would desire to receive his statement weekly, daily, or possibly several times a day. [Examiner's Answer, Page 10-11]

20 4) Successful delivery to a printer would be verification that the printer successfully printed the document. Such printer monitoring means and methods are well known in the art and have been used extensively to monitor queues of documents assigned to network printers for at least the past two decades. [Examiner's Answer, Page 13]

25 5) [T]he Examiner would like to note that difficulty and inexactness of monitoring such consumables as paper, toner, ribbon or ink usage and using that information to project a need by the user for more of that product. While one could make an educated guess that if the printer has printed 5,000 pages of documents, the user may be getting low on paper (5,000 pages is the usual quantity of paper in a "case"), the Appellant has not disclosed how the system would determine how much paper the user had "on hand" in the beginning or how much paper was wasted, destroyed by the printer, or used for other projects (hand-written notes, etc). While monitoring the gross number of pages printed (printer usage) could give a person an estimate on the amount of consumables used by the printer, it is just that – an estimate. Consumables, such as toner cartridges, are notorious for running out unexpectedly or for lasting well beyond their expected consumption date. Ink, especially, must also take into account the amount of evaporation experienced during periods of non-use. Therefore, since the references disclose monitoring the delivery of the electronic documents to the user's output device (device usage), it would have been obvious to make the advertisements and incentives the reference systems are providing to the user pertain to such consumable products. [Examiner's Answer, Pages 13 and 14]

In addition to being fundamentally unfair to Appellants, basing large portions of his arguments on anecdotal interpretations of allegedly prior art that is not of record in this case shows -- even after 5 years of examination -- that the Examiner has not met his burden of establishing a *prima facie* case of obviousness. By law, this means that the Appellants are entitled to a US patent.

In the instances in the Examiner's Answer where the Examiner does rely on the cited references, he improperly uses hindsight gleaned from Appellants' claimed invention to distort the reference's intended meaning -- and Appellants' claim language itself -- in an attempt to justify the rejection. But these attempts fall well short of what the law requires.

One example of this will now be discussed. In the Final Office Action, and on Page 3 of the Examiner's Answer, the Examiner correctly notes that Griebenow "does not explicitly disclose that the document will also be automatically printed on the user's printing device". But later, on page 9 of the Examiner's Answer, the Examiner contradicts his earlier position in stating that Griebenow discloses "that the electronic document could be downloaded to any location connected to the processor, which would include the...printer." This apparent shift in position, literally in the middle of the Examiner's Answer, is unclear (and unfair) to the Appellants. What is clear (and fair) is that Griebenow teaches away from this argument in Column 10, Lines 31-47:

... For example, if the consumer uses the publication for only 10 minutes, then an advertisement may be displayed after only 5 minutes of use when the consumer next uses the publication. This feature would prevent a consumer from trying to avoid viewing advertising by terminating reading application 20 each time an advertisement was about to be displayed. [Emphasis added]

The concept of "using" a document for a period of time, and forcing the display of advertising on that document for a subset of that period of time, clearly teaches away from the concept of printing a document. It illustrates how

Griebenow does not disclose, teach, or suggest the printing of such a document, and cannot form the basis of a rejection of Appellants' claimed invention – either alone or together with Austin.

5 Another example of the Examiner improperly using hindsight gleaned from
Appellants' claimed invention in distorting the meaning of the cited references is
the discussion on pages 9 and 10 of the Examiner's Answer. The Examiner
states that both Griebenow and Austin disclose printing documents at a "user-
specified time" (a summarized version of one element of Appellants' claim 1:
10 "storing a print schedule with an indication that the document should be printed at
a user requested time..."). To support this contention, the Examiner says that
Griebenow discloses that the "timing engine 50 will create events at the
appropriate time intervals when delivery of the electronic publication is proper."
[emphasis added] But delivering a publication when it "is proper" is clearly
15 considerably different than – and does not disclose – "storing a print schedule
with an indication that the document should be printed at a user requested time",
as Appellants are actually claiming.

Still another example is the Examiner's assertion on page 10 of the
20 Examiner's Answer that the Austin reference's disclosure of "the user being able
to modify delivery options" discloses "storing a print schedule with an indication
that the document should be printed at a user requested time", as Appellants are
actually claiming. To support this assertion, the Examiner refers to Fig. 4D in
Austin which he states "shows that one of the characteristics of the statement
25 distribution system is the 'Delivery Frequency', which is listed on the exemplary
figure as 'Monthly'. Members of the Board, please do look at Fig. 4D of Austin.
See how the user can put a check box next to the inverse-bolde fields for
"Email", "Excel", MS Money", "Fax" and "Print", and thus specify the delivery
medium. See how the user can press one of the inverse-bolde buttons at the
30 bottom of the screen. See that the "delivery frequency" of "monthly" that the
Examiner relies upon to justify this rejection is not inverse-bolde, and thus is not

modifiable by the user *at all*. See that the description of Fig. 4D in Austin in Column 10, lines 12-32 supports everything that Appellants are saying – that Austin does not disclose, teach, or suggest “storing a print schedule with an indication that the document should be printed at a user requested time”, as
5 Appellants are claiming.

Appellants could go on, but to do so would just repeat Appellants’ Appeal Brief. Instead, the Board is respectfully requested to read Appellants’ Appeal Brief and give it your fair and reasoned consideration. Appellants’ Appeal Brief
10 focuses on their invention, *as claimed*, and what was actually disclosed, taught and suggested in the prior art, *as properly cited*. Appellants would very much appreciate it if the Board would do the same and allow this application to issue. Appellants have patiently waited for over 5 years now for this patent application
15 to issue, and have believed throughout this time that the patent laws require such issuance to occur. The Examiner has not met his burden of establishing a *prima facie* case of obviousness. Appellants respectfully request reversal of these rejections from the Board of Patent Appeals and Interferences, along with timely
issuance of a notice of allowance of claims 1-22, 33-48, and 77-85.

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Respectfully Submitted,

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